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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket No.: REICHSTEIN

In re Application of:	
ULRICH REICHSTEIN et al.	**Examiner: Heitbrink, Timothy W**
Appl. No.: 10/603,459	**Group Art Unit: 1722**
Filed: June 25, 2003	
For: INJECTION MOLDING MACHINE WITH ELECTRIC COMPONENTS LINKED IN WIRELESS MODE	

BRIEF OF APPEAL

Date: March 6, 2006

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450", on **March 6, 2006.**
(Date)

HENRY M. FEIEREISEN
Name of Registered Representative

Signature

3-6-2006
Date of Signature

S I R:

This is an appeal from the final rejection of claims 1-4 by the Primary Examiner. The Brief is being filed under the provisions of 37 C.F.R. §41.37. A check in the amount of $500.00 to cover the requisite fee set forth in 37 C.F.R. §41.20(b)(2) is attached.

The Commissioner is hereby authorized to charge fees which may be required, or credit any overpayment to Deposit Account No. 06-0502.

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(1) REAL PARTY IN INTEREST

The above-referenced patent application has been assigned to Demag Ergotech GmbH, having a place of business at Altdorfer Strasse 15, 90571 Schwaig, Federal Republic of Germany, the real party in interest by virtue of an assignment recorded on May 10, 2004 at reel 015308, frame 0346 .

(2) RELATED APPEALS AND INTERFERENCES

There are no and there have been no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(3) STATUS OF CLAIMS

The following claims are in the proceeding:

Claims 1-4 stand rejected under 35 U.S.C. §112, first paragraph.

Claims 1-4 stand rejected under 35 U.S.C. §112, second paragraph.

Claims 1, 3 and 4 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,186,760 to Latham.

Claims 1 and 4 stand rejected under 35 U.S.C. §102(b) as being anticipated by either German Pat. No. DE 19909307 to Krause et al., or European Pat. No. EP 1128244 to Meschia, or the Abstract of German Pat. No. DE 20204359 (hereinafter "DE '359").

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over either of Latham, Krause et al., Meschia, or DE '359, and further in view of Applicant's admitted prior art.

(4) STATUS OF AMENDMENTS

Appellant has filed a request for a Pre-Appeal Brief Review. In accordance with the Panel Decision, mailed February 6, 2006, the application is to proceed to the Board of Patent Appeals and Interferences.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention, as set forth in claim 1, is directed to an injection molding machine with a machine control, and electric components, whereby the machine control and the electric components are operatively connected in wireless mode. During prosecution of the application, claim 1 has been amended to set forth that the machine control as well as the electric components are internal parts of the injection molding machine.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Issue 1-Whether claims 1-4 are definite under 35 U.S.C. §112, first paragraph?

Issue 2-Whether claims 1-4 are definite under 35 U.S.C. §112, second paragraph?

Issue 3-Whether claims 1, 3 and 4 are anticipated under 35 U.S.C. §102(b) by Latham?

Issue 4-Whether claims 1 and 4 are anticipated under 35 U.S.C. §102(b) by either Krause et al., or Meschia, or DE '359"?

Issue 5-Whether claim 2 is patentable under 35 U.S.C. §103(a) over either of Latham, Krause et al., Meschia, or DE '359, and further in view of Applicant's admitted prior art?

(7) ARGUMENT

ISSUE 1-WHETHER CLAIMS 1-4 ARE DEFINITE UNDER 35 U.S.C. §112, FIRST PARAGRAPH?

The Examiner rejected claim 1 because of the absence of support for the term "internal" in the original specification.

Appellant has incorporated the term "internal" to expressly set forth that the machine control and the electric components are parts that are incorporated in the machine so that the wireless transmission is realized internally. As described in the instant specification in paragraph **[0005]**, a drawback of prior art machines is the provision of cables to connect electric components of the machine because of the risk of contact with hot surfaces that can lead to a melting of cables, or risk of damage. To address these problems, the inventors contemplate the provision of a wireless communication between parts of the machine to replace hardware connections (paragraph **[0008]**) and thereby minimize the use of cables (paragraph **[0006]**)

Reference is made to paragraph **[0003]** of the instant specification, noting the connection between the electric components to a machine control and/or to an **external** computer. This paragraph distinguishes between the parts of the injection molding machine, namely electric components and machine control and an external part, namely external computer. Thus, while not expressly referring to "internal", it is appellant's contention that this paragraph unambiguously implies that the electric components and the machine control are "internal" parts. It is also well established that "the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. *Ex parte Parks*, 30 USPQ2d 1234 (B.P.A.I. 1994).

It is appellant's contention that the originally filed disclosure conveys to one skilled in the relevant art the concept of wireless communication between the

machine control and the electric components internally inside the injection molding machine.

Reference is also made to paragraph **[0011]** of the instant specification and claim 4, which set forth the provision of an **external** device. The express reference to an external device, again, is intended to distinguish from the "internal" parts, set forth in claim 1. Otherwise the use of "external" would serve no purpose under the "claim differentiation" doctrine. (see *Forest Laboratories, Inc. v. Abbott Laboratories,* 239 F.3d 1305, 1310, 57 USPQ2d 1794 (Fed. Cir. 2001), stating: "Where claims use different terms, those differences are presumed to reflect a difference in the scope of the claims".).

Reference is made to paragraph **[0017]** of the instant specification, listing plural components, including machine control and electric components, of the injection molding machine that are provided on the machine (line 5, of paragraph **[0017]**). An example of an electric component operatively connected to the machine control is a temperature sensor (paragraph **[0018]**) for measuring the temperature of plastic melt in the hot runner of the injection molding machine. Although not stated expressly, the temperature sensor clearly constitutes an "internal" part of the injection molding machine.

In summary, ample support can be found inherently in the original specification for the term "internal". (see *In re* Nathan, 328 F.2d 1005, 140 USPQ 601 (C.C.P.A. 1964), stating that a "subsequent clarification of or a change in an original disclosure does not necessarily make that original disclosure fatally defective."). It is applicant's belief that the instant specification satisfies the requirement under section 112, first paragraph.

For the reasons set forth above, it is respectfully requested to reverse the rejection of claim 1 and all claims dependent on claim 1 under 35 U.S.C. §112, first paragraph.

ISSUE 2-WHETHER CLAIMS 1-4 ARE DEFINITE UNDER 35 U.S.C. §112, SECOND PARAGRAPH?

As discussed under the previous heading, there is ample support in the original specification for the term "internal" in connection with the machine control and electric components as forming internal parts of the injection molding machine. Nothing in the disclosure suggests any reference to a "room", as the Examiner noted. The inherency of the term "internal" as well as the actual use of the term "external" are unambiguous, and clearly relate to the injection molding machine, namely as part thereof ("internal") or to areas remote to the injection molding machine ("external").

In the case at hand, one skilled in the art would understand the scope of claim 1, when read in light of the specification, even though the claim terminology "internal" does not appear in the specification. As noted in Webster's Third International Dictionary, 1961, page 1180, the term "internal" is defined as "*existing or situated within the limits or surface of something*". Claims are interpreted in light of the specification, and the specification is directed to the configuration of an injection molding machine, which as stated in paragraph **[0006]**, should be constructed "to obviate prior art shortcomings and to minimize the use of cables". Nothing in the specification supports the Examiner's interpretation that the use of the term "internal" could also relate to "a room".

It is appellant's contention that the claim language is definite and clear to one skilled in the art.

For the reasons set forth above, it is respectfully requested to reverse the rejection of claim 1 and all claims dependent on claim 1 under 35 U.S.C. §112, second paragraph.

ISSUE 3-WHETHER CLAIMS 1, 3 AND 4 ARE ANTICIPATED UNDER 35 U.S.C. §102(B) BY LATHAM?

Claim 1 sets forth the wireless communication between machine-internal parts, namely machine control and electric components. This claim limitation is neither expressly nor inherently disclosed in the Latham.

The Latham reference describes a system for monitoring and controlling a blow mold machine by using a wireless communication between the machine and a computer at a **remote** (external) site (col. 3, lines 41 to 44). In contrast thereto, the present invention is directed to the provision of a wireless transmission between internal parts of the machine.

For the reasons set forth above, it is applicant's contention that Latham neither teaches nor suggests the features of the present invention, as recited in claim 1, and the rejection of claim 1 under 35 U.S.C. 102(b) should be reversed.

As for the rejection of the dependent claims 3 and 4, these claims are considered allowable by virtue of their dependencies from claim 1.

It is therefore respectfully submitted that the rejection of claims 1, 3 and 4 under 35 U.S.C. 102(b) should be reversed.

ISSUE 4-WHETHER CLAIMS 1 AND 4 ARE ANTICIPATED UNDER 35 U.S.C. §102(B) BY EITHER KRAUSE ET AL., OR MESCHIA, OR DE '359"?

The Krause reference discloses a wireless communication between an **external** PC (laptop 11) and a machine (see col. 3, lines 27 to 32 and the Figure). Krause describes in col. 4, lines 37 to 39 as follows:

> *The portable industrial PC 12 has an aerial 13 which is in communication with an aerial 14 on the plastics machine. Between both, the wireless connection according to the invention is established."*

Thus, also Krause is silent as to a wireless transmission between internal parts of a single machine.

The Meschia reference discloses a wireless network system for connecting various machines via a server. While Meschia also desires to eliminate a need for wiring, it is concerned, however, with the wiring between **separate and distant** machines (see, e.g., paragraph [0025] in col. 4). Thus, also Meschia is silent as to a wireless transmission between internal parts of a single machine.

DE '359 discloses an injection molding machine with programmable system for monitoring an control and uses a wireless communication between the machine and an **external** processing unit. Thus, also DE '359 is silent as to a wireless transmission between internal parts of a single machine.

For the reasons set forth above, it is applicant's contention that neither Krause, nor Meschia, nor DE '359 teaches nor suggests the features of the present invention, as recited in claim 1, and the rejection of claim 1 under 35 U.S.C. 102(b) should be reversed.

As for the rejection of dependent claim 4, this claim is considered allowable by virtue of their dependencies from claim 1.

ISSUE 5-WHETHER CLAIM 2 IS PATENTABLE UNDER 35 U.S.C. §103 OVER EITHER OF LATHAM, KRAUSE ET AL., MESCHIA, OR DE '359, AND FURTHER IN VIEW OF APPLICANT'S ADMITTED PRIOR ART?

Since claim 2 depends from claim 1 and contains all the limitations of claims 1, claim 2 is patentable over the applied prior art in the same manner as claim 1.

It is therefore respectfully submitted that the rejection of claim 2 under 35 U.S.C. 103(a) should be reversed.

(8) CONCLUSION

Appellant has invented a machine of making molded articles, such as an injection molding machine, which is constructed to have wireless communication between machine-internal parts, namely machine control and electric components.

The cited prior art does neither teach nor suggest the subject matter as defined in claim 1 of the present invention. Although the Examiner noted on page 4, third full paragraph of the Final Rejection, dated September 12, 2005, that "[*T*]*he machine controls and electric components of each of the references are either internal to the machine itself or in the very least internal to the room in which they are located.*" This assessment is not well-founded and not supported by the references. Nothing in the disclosures of the references relates to a construction of a machine which is wired wirelessly internally, and the Examiner could also not relate to any specific portions (page and line or figure) of each of the references the Examiner refers to base his rejection on. In addition, as outlined under the previous headings, the reference to a "room" where the machine may be located is immaterial to the subject matter, as set forth in claim 1.

Therefore, the rejection of claim 1 on this prior art is not well taken.

For the above stated reasons, it is respectfully submitted that the rejection of the claims 1-4 issued by the examiner on the references should be reversed.

Respectfully submitted,

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(9) CLAIMS APPENDIX

1. A machine of making molded articles of plastic or rubber, such as an injection molding machine, extruder or blow molding machine, comprising an internal machine control; and a plurality of internal electric components which are operatively connected through wireless communication to the machine control, wherein the machine control and the electric components have means for transmitting and receiving electromagnetic waves.

2. The machine of claim 1, wherein the wireless communication is configured to conform to Bluetooth wireless technology.

3. The machine of claim 1, wherein the plurality of electric components includes a detector selected from the group consisting of temperature sensor, displacement sensor, pressure sensor, wherein the detector includes a converter for converting a measuring signal into a signal transmittable in wireless mode.

4. The machine of claim 1, and further comprising at least one external device selected from the group consisting of PC and printer, and linked in wireless mode to the machine control.

(10) EVIDENCE APPENDIX

NONE

(11) RELATED PROCEEDINGS APPENDIX

NONE